UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,950	04/09/2001	Masahiro Nakano	SOA-330	6685

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EXAMINER
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ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____ .
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-21* is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1-21* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All   b) ☐ Some * c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
> *(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

2.   Claims 1-4, and 6-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Kung et

al. (U.S. Patent No. 6,373,817 B1).

Regarding claim 1, Kung discloses "an apparatus for filtering electronic mail and

notifying a user, residing on a set box connected between a television content provider, an

Internet provider having an e-mail server, and a television" (Fig. 1, for users at terminals 142 or

wireless 144 receiving contents including e-mails from the Internet 180 via an Internet provider

or Administration 155 connected to an IP central station 200, with a television content provider

at head end hub 115, terminals including a television, a set top terminal or a set top box, refer to

col. 4/lines 22-60), comprising:

a software program which enables a user specify filter criteria and notification icons

which then retains and stores said e-mail filter criteria and icons; a querying module contained

within said software program which queries said e-mail server to determine whether e-mail

fulfilling said e-mail filter criteria has arrived at said e-mail server (Figs. 7a, 8 & 10 for a

software program allowing the user to define and set up a calling schedule for himself/herself or

a calling preference in filtering e-mail or message intended for him/her and for the server to

know whether to retain and store the message, see Fig. 2 and col. 13/lines 7-26 for a multimedia

server 222 for e-mail supports; col. 34/line 20 to col. 35/line 5 for chase me feature; and col.

35/line 44 to col. 36/line 35 for filtering and scheduling of calls or messages);

a notifying module also contained within said software program wherein, upon arrival of

an e-mail fulfilling said criteria, said application notifies the user by posting said notification

icons to the set box, i.e., col. 29/lines 27-44 for a query addressed; and col. 30/lines 15-31 for

call or message alerting; and col. 23/lines 4-22 for an instant message included.

As for claims 2 and 3, Kung discloses "wherein the connection between said set top box

and said mail server is permanent, so that said application continually queries said e-mail server"

and "wherein the connection between said set top box and mail server is non-permanent, so that

said application queries said e-mail server at specific timed intervals", i.e., depending on the

user's preference whether to receive the e-mail or message notification from the server

continually or at specified time intervals, the application is performing as shown in Figure 10

whether to accept the message or filter the message at any time of day and any day of week (Fig.

10, and col. 35/line 44 to col. 36/line 35).

As for claim 4, Kung further discloses "wherein said set top box contains an multi-

tasking Operating System and said application runs on top of said Operating System" (col.

21/line 34 to col. 22/line 25 for a multi-tasking operating system).

As for claims 6 and 7, Kung shows "wherein said application notifies the user of the

existing e-mail messages fulfilling said e-mail filter criteria through a notification icon on the

television screen" and "wherein said notification icon is configurable by the user, and reflects the

content of the e-mail filter criteria" (col. 22/line 37-col. 23/line 22 for status screen with icons

and messages or e-mail notifications).

As for claims 8 and 9, Kung further discloses "wherein said application notifies the user

through the use of an tone generated through the television speaker" and "wherein said tone is

configurable by the user, and reflects the content of the e-mail filter criteria" (col. 22/line 37-col.

23/line 22 for status screen with icons and messages or e-mail notifications; and col. 30/lines 15-

30 for audio tones alerts).

As for claim 10, Kung shows "wherein said application notifies the user of a plurality of

said e-mail messages wherein each e-mail message satisfies different filter criteria and has a

different user notification icon" (Figs. 7a & 7b & 8 for different filter criteria; and col. 22/line

45-63 for different icons addressed).

As for claim 11, Kung discloses "wherein said application queries said e-mail server

upon power-up of said set box, and immediately notifies the user of the existence any e-mail

messages satisfying the user-specified e-mail filter criteria" (col. 30/lines 15-52 as notification is

delivered to the user as soon as the off-hook network connection-power off- is connecting to the

network again).

As for claim 12, Kung discloses "wherein said application notifies the user via a pager

rather than through said set top box" (col. 38/lines 13-36 for pager and notification to the user's

pager).

As for claim 13, Kung discloses "wherein said application notifies the user of the

existence a telephone call with Caller ID satisfying said filter criteria, instead of an e-mail

message" (col. 22/lines 37-49 for caller ID).

As for claim 14, Kung discloses "wherein said application notifies the user of another user attempting to make Instant Message contact with said first user" (col. 22/line 58 to col. 23/line 22 for instant message addressed).

As for claim 15, Kung shows "wherein newer versions of said application are downloaded to said set top box by said Internet provider" (col. 36/lines 5-35 as missing plug-ins or software can be downloaded to the set top box from the service provider).

As for claim 16, Kung discloses "wherein said downloading of newer versions can distinguish between different types of set top boxes, and make adjustments to content said download accordingly", i.e., each user of the set top or terminal has their own ID for billing purposes and ordering including authentication for use within the network, see col. 12/lines 1-15; And col. 36/lines 18-35 as newer versions or new plug-ins or software can be requested and charged or free of charge based on available services from the service provider.

As for claims 17 and 18, Kung shows "wherein said application is not resident on said set top but resident on said e-mail server" and "wherein said set top box is connected to said e-mail server through a middle server, where said application resident on said middle server" (Fig. 2 shows an IP central control with multimedia server 222 for e-mail as noted above; and the process is performed at the IP central station, see col. 7/line 35 to col. 8/line 60).

Regarding claim 19, Kung discloses "a method of filtering e-mail messages and notifying a user, comprising: installing a software program on a set box, wherein said set top box connected both to a TV content provider and an e-mail server; configuring said program with specific e-mail criteria and also notification symbols; queuing incoming e-mail messages at said e-mail server; querying said e-mail server as to whether any of said queued messages fulfill said

criteria; notifying a user that e-mail messages fulfilling said criteria are available on said e-mail server" (refer to claims 1-4 above).

Regarding claim 20, Kung discloses "an e-mail filtering and notification application, comprising: a set top box, connected between TV content provider, an Internet provider having an e-mail server, and a user-input means for allowing a user specify e-mail filter criteria and notification icons; retaining and storing means for retaining and storing said criteria and icons; querying means, for querying said e-mail server to determine whether e-mail fulfilling said user criteria has arrived at said e-mail server; notification means for notifying the user said arrival by posting said notification icons the Set Top Box" (refer to claims 1-4 above).

Regarding claim 21, Kung discloses "an software application for filtering electronic mail and notify a user, residing on a set top box connected between a television content provider, an Internet provider having an e-mail server, and a television, comprising: said software program enabling a user to specify e-mail filter criteria and notification icons which then retains and stores said e-mail filter criteria and icons; a querying module which queries said e-mail server to determine whether e-mail fulfilling said e-mail filter criteria has arrived at said e-mail server; a notifying module wherein, upon arrival of an e-mail fulfilling said criteria, said application notifies the user by posting said notification icons to the set top box" (refer to claims 1-4 above).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> *(a) A patent may not be obtained though the invention is not identically disclosed or
> described as set forth in section 102 of this title, if the differences between the subject
> matter sought to be patented and the prior art are such that the subject matter as a whole
> would have been obvious at the time the invention was made to a person having ordinary
> skill in the art to which said subject matter pertains. Patentability shall not be negatived
> by the manner in which the invention was made.*

4.   Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kung et al. (U.S.

Patent No. 6,373,817 B1) in view of Skinner et al. (U.S. Patent No. 6,397,167 B2).

Regarding claim 5, Kung does not disclose the step of "wherein said set top box contains

an single-tasking Operating System and said application remains memory as a Terminate and

Stay Resident (TSR) program and runs intermittently at user-configurable intervals"; however,

this is well known in the art. In fact, Skinner teaches a same technique in using TSR program for

memory applications within the set top box, and the user controls and runs intermittently at user-

configurable intervals (see Skinner, col. 8/line 43 to col. 10/line 36 for windows applications and

TSR programs addressed). Therefore, it would have been obvious to one of ordinary skill in the

art at the time the invention was made to modify Kung's system with Skinner's detailed

technique in TSR programs in order to provide applications to the system at the user's

configurable intervals, for instance, at the user's keystroke or input as taught by Skinner.

Conclusion

5.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Marcus (US 2002/0092019 A1) discloses a method and apparatus for creation, distribution,

assembly and verification of media.

Lauder et al. (US Pat. No.6,253,238 B1) disclose an interactive cable television system with

frame grabber.

Paz et al. (US 2002/0053075 A1) disclose a computer remotely accessed.

Lawrence et al. (US Pat. No.6,628,415 B2) disclose a remote plug-and-play for home printer via

cable network.

6.   **Any response to this action should be mailed to:**

        Commissioner of Patents and Trademarks

        Washington, D.C. 20231

or faxed to:

        (703) 872-9306, (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

7.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Krista Kieu-Oanh Bui whose telephone number is (703) 305-0095. The

examiner can normally be reached on Monday-Friday from 9:00 AM to 6:30 PM, with alternate

Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Christopher Grant, can be reached on (703) 305-4755.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Krista Bui
KB   Primary Examiner
Mar.28, 2005   Art Unit 2611

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